

**REMARKS**

Claims 1-59 were previously pending in this application. By this amendment, Applicant is canceling claims 42-59, without prejudice or disclaimer, as a result of a Restriction Requirement. Claim 1 is amended herein. No new claims have been added. As a result claims 1-41 are pending for examination with claim 1 being the sole independent claim. No new matter has been added.

**Claim Amendments**

Claim 1 is amended herein to recite that the substrate includes a first fluid passageway that is “formed within the substrate body,” that the manifold includes a fluid passageway “formed within the manifold body” and that the substrate includes a channel “the channel being adapted to position the manifold within the channel.”

**Rejections Under 35 U.S.C. §103**

The Office Action rejects claims 1-15 and 18-34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,629,546 to Eidsmore et al. (hereinafter “Eidsmore”) in view of U.S. Patent No. 6,615,871 to Ohmi et al. (hereinafter “Ohmi”). Applicants respectfully submit that the combination asserted by the Examiner is improper and fails to establish a *prima facie* case of obviousness because Eidsmore teaches away from a combination in which a substrate includes a fluid passageway formed within the substrate body.

The Office Action asserts that Ohmi teaches an “equivalence” between an “integral block” and a “substrate/manifold” and further asserts that Eidsmore teaches the use of a block to accept a bridge fitting while Ohmi describes the use of bridge fittings and a separate use of blocks with drilled passages. (Office Action at page 3.) The Office Action also offers that there are “many patents” concerning integral blocks with drilled passages and “many others” concerning blocks with channels. *Id.*

Applicants respectfully assert that the applicable legal standard of obviousness under 35 U.S.C. §103(a) is not whether there is a degree of “equivalence” between a manifold and an integral block with internal fluid passageways, but as an initial matter, whether there is some suggestion or motivation to combine the teachings of the prior art to produce the claimed invention. (M.P.E.P. §2143.01) In particular, whether there is any such suggestion or

motivation in view of the teachings of the references that are being combined. Applicants assert that there is not.

Eidsmore expressly describes the disadvantage of employing a substrate body with a fluid passageway formed within it and describes that “the present invention” of Eidsmore reduces the volume of expensive material “as compared to the conventional ... blocks,” i.e., reduces the volume of expensive material when compared with blocks that include an internal fluid passageway. (Col. 1, lines 53-59 and Col. 5, lines 35-54.) As a result, Eidsmore avoids the use of internal fluid passageways in a substrate because “prior art modular component blocks use a large volume of expensive material” while “the present invention [of Eidsmore] provides a gas flow passage that is defined by a bridge fitting 50 which has a substantially reduced volume of expensive material ... this results in a more economic gas path manifold which is cheaper and easier to make than the prior art component blocks.” (Col. 5, lines 47-54.) Indeed, the entire disclosure of Eidsmore is directed to manifold assemblies designed to conduct process fluid through manifold bridges instead of through fluid passageways formed in the body of the substrate.

Because Eidsmore discredits and expressly teaches away from the use of internal fluid passageways in a substrate, the combination proposed in the Office Action is improper and the Office Action fails to present a *prima facie* case of obviousness in view of claim 1 as amended. The potential availability of various approaches and their alleged “equivalence” do not provide a suggestion or motivation to combine the cited references to produce the claimed invention because Eidsmore expressly teaches away from the asserted combination. (M.P.E.P. §2143.01, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”) Similarly, in view of the express language of Eidsmore, the general teachings of the “many patents” referred to in the Office Action also fail to provide the missing suggestion or motivation.

Accordingly, for at least the above reasons, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §103(a) be reconsidered and withdrawn. In addition, Applicants respectfully assert that each of the dependent claims 2-15, and 18-34 is also allowable because each depends either directly or indirectly from claim 1 and request that the rejections of claims 2-15 and 18-34 also be reconsidered and withdrawn.

The Office Action also rejects dependent claim 37 under 35 U.S.C. §103(a) as allegedly being unpatentable over Eidsmore in view of Ohmi as applied to claim 1 and further in view of U.S. Patent No. 6,634,385 to Symington ("Symington"). Claim 37 depends from claim 1. Applicants respectfully assert that claim 37 is allowable because Symington also fails to cure the deficiencies of Eidsmore and Ohmi as applied to claim 1 and request that the rejection of claim 37 also be reconsidered and withdrawn.

#### Allowable Subject Matter


Claims 16-17, 35-36 and 38-41 are indicated as containing allowable subject matter. Applicants have deferred re-writing claims 16-17, 35-36 and 38-41 in independent form in view of the arguments provided herein regarding the patentability of the independent claim from which they depend.

#### CONCLUSION

In view of the foregoing amendments and remarks, reconsideration is respectfully requested. This application should now be in condition for allowance; a notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50/2762.

Respectfully submitted,  
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